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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,652	10/17/2001	Russell M. Krapf	K35A0762	8126

35219 7590 06/21/2006

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EXAMINER

BUI, KIEU OANH T

ART UNIT PAPER NUMBER

2623

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/982,652	Applicant(s) KRAPP ET AL.	
	Examiner KIEU-OANH T. BUI	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-48, drawn to a method for displaying a targeted advertisement to a viewer of a display in conjunction with displaying a broadcast stream, classified in class 725, subclass 34.
 - II. Claims 49-78, drawn to a personal video recorder for sending a target advertisement to a display for viewing by a viewer in conjunction with viewing a broadcast stream on the display, classified in class 725, subclass 55.
2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the use of a personal video recorder as in Group II for sending a target advertisement is not required in Group I.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Jason Evans on 06/01/2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-48.

Affirmation of this election must be made by applicant in replying to this Office action. Claims 49-78 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Hite et al. (U.S. Patent No. 5,774,170).

Regarding claim 1, Hite discloses a method for displaying a targeted advertisement to a viewer of a display in conjunction with displaying a broadcast stream on the display comprising the first three steps a-c (as claimed) for the displaying of a broadcast stream or video stream based on the selection from the user/viewer using a viewing control interface, i.e., a remote control (see Fig. 5, item 446 for the remote controller; and col. 14/lines 21-58 as the controller selects which broadcast signal stream for displaying to the user/viewer). Hite further teaches the

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last three steps as the user profile is used for determining the first targeted advertisement delivered to the viewer (Fig. 2 and col. 11/lines 13-30).

As for claims 2-9, these repetitive claims simply refer to the viewer update profile to the headend, and based on the updated viewer profile, the updated or second advertisement is delivered or broadcasted to the viewer (col. 3/line 65 to col. 4/line 23; col. 11/lines 13-45 for the algorithm to consistently update the consumer database and provide updated and appropriate advertisements to the viewer).

As for claim 10-13, Hite teaches these features for displaying ID of at least one of the stored advertisements, menu or list of advertisements on the display, including a banner or an icon (refer to Figs. 2 & 3; and col. 9/line 43 to col. 10/line 53).

As for claims 14-16, Hite further teaches these features as the updated (second) advertisement needs to follow the first advertisement, i.e., even the viewer changes the channel, the advertisement can be continued to complete on the new channel (col. 7/line 65 to col. 8/line 17); and the displaying for the above advertisements are at the same time for displaying regularly scheduled advertisements within the broadcast stream (col. 7/line 65 to col. 8/line 17 for the displaying time slots are adjacent and on the regularly scheduled advertisements).

As for claims 17-20, Hite further discloses wherein the broadcast stream is a TV broadcast stream, a cable broadcast stream, a satellite broadcast stream, and an Internet broadcast stream (col. 5/lines 40-50; col. 6/line 60 to col. 7/line 14; col. 7/line 52-col. 8/line 17; and col. 13/line 58 to col. 14/line 58 for a wide range of sources and digital/analog/coaxial, cable, satellite, cable modem etc.).

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As for claims 21-24, Hite further teaches these features as the object of Hite is to target advertisements to each viewer based on their profile (col. 3/lines 20-28 & col. 4/lines 3-18), and the advertisements can be stored on a hard disk (Fig. 5/item 456 and col. 14/lines 32-46 for storing and playback including the commercials or advertisements).

As for claims 25-48, these claims with same features as claimed earlier are rejected for the reasons given in the scope of claims 1-24 as disclosed in details above.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hite et al. (U.S. Pat. No.6,002,393) disclose a system and method for delivering targeted advertisements to consumers using direct commands.

Hendricks et al. (U.S. Pat. No.5,990,927) disclose an advanced set top terminal for cable television delivery systems.

Srinivasan et al. (US 2001/0023436 A1) disclose a method and apparatus for multiplexing separately-authored metadata for insertion into a video data stream.

Watchfor gel et al. (US 2002/0138831 A1) disclose advertisements in an end-user controlled playback environment.

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6. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krista Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu-Oanh Bui
Primary Examiner
Art Unit 2623

KB

June 13, 2006